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09/595,388	06/14/2000	Asil T. Gokcebay	537P	8754

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Thomas M Freiburger
25th Floor
650 California Street
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EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 05/06/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/595,388

Applicant(s)

GOKCEBAY ET AL.

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8</u> . | 6) <input type="checkbox"/> Other: _____ |

Examiner's Response

1. In response to applicant's amendment filed 2-17-04, all the amendments to the specification and claims have been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinar (US 5003801), Seckinger (US 4686358) and Bolan (US 4945217).

Stinar discloses a key device of independent claims 1, 15, 18 and 25 with metal (steel or brass) blade or shank 14 double cut with a pattern of bitting shown in fig. 1 and formed into a head or handle 12 at the upper end including a data contacts or terminals (16 and 18) isolated from the shaft. The key shaft

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for the ground terminal and the head includes an ID device or code element 111-118. See col. 2 lines 11-61. The ID device may be a programmable memory in col. 3 lines 48-52. Data is communicated via a single data terminal corresponding to a one wire bus. Regarding claim 2, the handle portion formed at the upper end of the shaft in col. 2 lines 14-15 represents an integral blade and head. Regarding claim 11, the data contact is in the front of the head adjacent to the key shoulder in fig. 1 and col. 2 lines 13-16. Regarding claim 17 and 20, the key shaft acts as a ground contact in col. 2 lines 37-42 and col. 3 line 1. Regarding claim 26, the key cuts 14 interacting with tumblers in col. 2 lines 24-27 acts as retention means.

Stinar does not expressly disclose that the identification device or memory cell is in the form of a self contained, sealed can unit comprising a metal casing.

Bolan discloses an electronic key or token such as DS1207 including an integrated single chip with serial access memory communicating using a one wire bus protocol. The device includes a flexible circuit board, battery and two external contacts to form a sealed durable package that may be attached to an item to be tagged. See col. 1 line 57 - col. 2 line 62. This device includes a circular, coin or button shaped metal casing shown in fig. 1A and known as a touch memory or iButton.

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The casing has external finished dimension of 16mm wide and 3.2 mm thick. Note that col. 2 line 8 expressly recites that chips in the button may include, for example, "electronic keys (such as the DS1207)." Further col. 33 lines 47-54 again refers to the DS1207 for "security features" where "security is a high priority" stating that:

Advantageous applications of this type may include "smart cards", personal identification badges, and electronically verified currency.

Seckinger discloses a programmable electronic key with a metal shaft or shank 1 having coding or bitting 3 and a grip or head 2 with recesses 6A-D for receiving circuits including contacts, connectors, processor, memory and battery. At least the battery recess is circular in shape has a metal housing of standard key dimensions for mechanical strength and stability that may include a non-detachable closure and may have plastic shell covers. See col. 2 lines 28-68 and col. 3 line 39 - col. 9 line 9. Memory is recited in claim 10.

Regarding clams 1-2, 11, 15, 17, 18, 20 and 25-26 it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Stinar the identification device or memory cell in the form of a self contained, sealed can unit comprising a metal casing because this is housing is disclosed in Bolan to provide advantages such

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as a sealed durable package that may be used as an "electronic key" for advantageous security applications. Bolan provides further suggestion by stating in col. 34 lines 56-66 that packaging may be varied to include connectors. If one wire bus is not clear in Stinar then it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a one wire bus protocol in the key of Stinar in view of the one wire bus used in Bolan as an electronic key for security applications because this is suggested by the communication over one data terminal in Stinar and because Bolan includes advantages such as a sealed durable package. This combination is further suggested by the key of Seckinger including flexible circuit board and circular recess to receive a button shaped device resembling the device of Bolan. If an integral key shaft and head is not clear in Stinar then such would have been obvious in view of integral metal key shank and grip of Seckinger for mechanical strength and stability. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a one wire bus protocol in the key of Seckinger in view of the one wire bus used in Bolan as a key or token because this is suggested by the communication over one data terminal in the key of Stinar and because Bolan includes advantages such as a

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sealed durable package. This combination is further suggested by the key of Seckinger including flexible circuit board and circular recess to receive a button shaped device resembling the device of Bolan. Regarding claims 3-5, 7-8, 16 and 19 Seckinger includes a recess to receive the ID device and battery, the particular dimensions would have been obvious in view of the dimension of the button shaped device of Bolan and suggested by the circular recess for button shaped device of Seckinger. Regarding claim 6, the device of Bolan includes a battery for power. Regarding claims 9-10 Seckinger includes a plastic cover with two half shells in col. 7 lines 7-8 and conductors 8A suggested by the handling with molded insulating material in claim 8 of Stinar. Regarding claims 12-13, the Seckinger includes contacts 4 on both sides of the blade or shank for reversible operation similar to the two contacts of Stinar. Regarding claim 21, the device of Bolan is a sealed can with battery and memory on a flexible circuit board. Regarding claim 14, the sealed can including a microcontroller would have been obvious in view of the processor on a flexible circuit board connected to battery in Seckinger. Regarding claim 26, the key blade mechanical coding of Stinar or Seckinger function as retention means.

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5. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinar (US 5003801), Seckinger (US 4686358) and Bolan (US 4945217) as applied above and further in view of Lemelson (US 4200227). Lemelson discloses a metal key 11 with teeth 14 on the blade and electronic code circuits or chips (36,38) disposed in recesses (34,35) of a two part plastic cover (21,30) forming housing 20 over the head 15. See col. 2 line 27 - col. 3 line 21. Alternatively, two button shaped circuits may be placed in a hole of the head and sealed to each other in col. 4 lines 19-39 to avoid an enlarged key head. This provides convenient circuit location that is simple and easy to assemble so that the circuits are sealed from corrosion in col. 1 line 5 - col. 2 line 10. Regarding claims 1-21 and 24-25 this structure of Lemelson including an integral solid metal key with circular recess receiving a circuit in a button shaped housing if further suggestion to deposit the button shaped circuit of Bolan in a recess in the head of and integral metal key. This provides the combination of a mechanical key coding and electronic coding with a sealed housing protecting the electronic circuits from corrosion. Regarding claims 22-24 two cells, or a cell and battery, would have further been obvious in view of the two button circuits sealed to each other in Lemelson as an alternative assembly to avoid the need of an enlarged key

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head. Two contacts are suggested by the symmetrical contacts of Stinar and Seckinger for reversible operation and separate circuit unit and batter are suggested by the circuit board 5 and separate battery 10 of Seckinger.

6. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinar (US 5003801), Seckinger (US 4686358), Bolan (US 4945217) and Lemelson (US 4200227) as applied above and further in view of Janssen (US 5836187), Sues (US 5229648), Suh (US 4697171) or Soong (UK 2291106). Janssen, Sues, Suh and Soong disclose electronic keys with contacts on the side of the blade. If contacts on the sides of the blades are not Seckinger then this would have been an obvious variation in location of parts in view of Janssen, Sues, Suh or Soong having contacts located on the blade. In particular, Sues includes contacts on the blade in fig. 2C as an alternative to contacts on the head near the shoulder of the blade in fig. 2A.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stinar (US 5003801), Seckinger (US 4686358), Bolan (US 4945217) and Lemelson (US 4200227) as applied above and further in view of Gelhard (US 4663952). If microcomputer is not clear in the combination applied above then such would

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have been obvious in view of Gelhard so that both the key and the lock include intelligence for highly sophisticated dialogue assuring extremely high security against sabotage in col. 4 liens 1-13 of Gelhard and suggested by the processor in col. 6 of Seckinger.

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stinar (US 5003801), Seckinger (US 4686358), Bolan (US 4945217) and Lemelson (US 4200227) as applied above and further in view of Clarkson (US 4789859). If mechanical coding (bits, cuts or depressions) on the shaft is not clearly key blade retention means in the combination applied above then such would have been obvious in view of Clarkson disclosing in col. 4 lines 44-47 use of a bit or notch interacting with a centering and retention device in the cylinder to ensure proper location of the key in the keyway.

Response to Arguments

9. Applicant's arguments filed 2-17-04 have been fully considered but they are not persuasive.

The objections to the specification and claims have been overcome by applicant's amendment. The 35 USC 102 rejection has been overcome by applicant's amendments adding limitations to the independent claims, but the 35 USC 103 rejections have not

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been overcome.

Applicant's arguments that Stinar lacks a self contained memory in a sealed metal can is not persuasive because the rejections are based on a combination of prior art including Bolan, wherein Bolan clearly teaches a self contained memory in a sealed metal can.

The argument that Bolan discloses a typical touch memory and a "wand" for reading tokens is not persuasive because Bolan clearly discloses an "electronic key" for security applications in col. 2 line 8 and col. 33 lines 47-54.

Applicant argues that the examiners comments read as though the examiner assumes the "token" of the Bolan patent is incorporated within some type of key, or perhaps with in the disclosed wand. The examiner has made no such "assumption" because Bolan expressly discloses an "electronic key" for security applications in col. 2 line 8 and col. 33 lines 47-54. The rejection does not rely on the "wand" of Bolan.

The argument that Bolan teaches nothing of relevance is not persuasive because Bolan expressly discloses an "electronic key" for security applications in col. 2 line 8 and col. 33 lines 47-54.

Applicant argues that the relevance of the battery in the key of Seckinger is not apparent. The examiner disagrees

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because applicant's claims include a battery and the battery of Seckinger is a metal button similar to the can of Bolan.

Although Seckinger includes plural contacts, it does include a circular housing for a can and the serial data output of Stinar and Bolan would provide an obvious simplification or reduction of parts.

Applicant argues that the examiner's reference to a key disclosed in Bolan is not understood. The examiner disagrees because Bolan expressly discloses an "electronic key" for security applications in col. 2 line 8 and col. 33 lines 47-54.

The argument that the flexible circuit board on Seckinger contradicts what is claimed is not persuasive because the button of Bolan includes such a flexible circuit board. The inclusion of such a flexible circuit board in the can of Bolan suggests inclusion of the circuit of Seckinger in such a can for security application. The flexible circuit board and battery in Seckinger does not teach away from applicant's invention because applicant admits that the claimed can is directed to the button of Bolan that includes a flexible circuit board and battery.

The argument that Lemelson was filed in 1978, when Bolan did not exist is not persuasive because the rejection is based on what would have been obvious to one of ordinary skill in the art "at the time the invention was made" and not at the time the

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applied art was filed.

In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

The argument that there is not showing of a one-wired bus in Lemelson is not persuasive because Bolan already discloses one wire bus. Lemelson is applied to teach a button shaped key memory circuit and corresponding circular recess in a key for receiving the button and the one wire bus is suggested by the serial communication of Stinar. Although Lemelson does not state that the button housing is metal, such would have been suggested to one of ordinary skill in the art by the metal button battery of Seckinger and/or the metal button touch memory with electronic key security application of Bolan.

The further argument that Lemelson lacks the one wire bus is not persuasive because Bolan discloses this as noted above and the button of Bolan would have been suggested by the button of Lemelson and the one wire bus is suggested by the serial communication of Stinar.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

CONTACT INFORMATION

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.


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Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (703) 305-4700 or TC 2600 Customer Service at (703) 306-0377.

Facsimile submissions may be sent via fax number (703) 872-9306 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (703) 305-4818. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704.

EH
5/3/04


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2635